



UNITED STATES PATENT AND TRADEMARK OFFICE

SD

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,025	08/01/2001	Luigi Guadagno	P-6098	5366

7590 01/12/2005

Jefferson Perkins, Esq.
Piper Marbury Rudnick & Wolfe
P.O. Box 64807
Chicago, IL 60664-0807

EXAMINER

LIN, WEN TAI

ART UNIT	PAPER NUMBER
----------	--------------

2154

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/920,025

Applicant(s)

GUADAGNO ET AL.

Examiner

Wen-Tai Lin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/1/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-32 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-32 are rejected under 35 U.S.C. 112 2nd paragraph because the following terms lack antecedent basis:

In claims 1, 11, 22 and 32:	"said dialog summary";
In claims 2, 13, and 23:	"said related posting summaries";
In claims 4-5, 7, 15-16, 18, 25-26 and 28:	"said given posting";
IN claims 9, 20 and 30:	"the initial posting";
In claims 10, 21 and 31:	"the group";
In claims 11 and 32:	"the email messages"; and
In claims 11 and 32:	"said related dialog summaries".

Claim Rejections - 35 USC § 102

Art Unit: 2154

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 11-14, 22-24 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Kennedy [U.S. Pat. No. 6330589].

5. As to claim 1, Kennedy teaches the invention as claimed including: a dialog facilitator preserving the spatial and temporal context of a dialog composed of a plurality of postings in an electronic messaging system, the postings being packaged into messages which are sent and received using a messaging system [col.2, lines 34-44; Fig.3; col.8, lines 23-32], said dialog facilitator comprising:

a services gateway exchanging messages with the messaging system [col.6, lines 18-31], and using information contained in the messages to populate a dialog posting and a posting summary [e.g., Fig.10a];

said dialog posting containing a posting identifier uniquely identifying the dialog posting [i.e., the message ID of Figs. 4a-4b or Figs. 6a-7] a dialog identifier identifying the dialog to which the dialog posting corresponds [e.g., the article numbers of Figs. 4a-

4b or Figs. 6a-7j, each uniquely identifying a group of messages], and posting detail information [i.e., the message itself];

said posting summary [e.g., Figs.4a-6b] containing addressing information identifying recipients of the corresponding dialog posting [col.6, lines 6-16; note that sender and recipient are default information contained in a mail], the posting identifier [i.e., the article number], the dialog identifier [i.e., the message ID], referential information [e.g., 112-124, Fig.4b] defining the relationship of the posting summary to other posting summaries in the dialog, and content description information [e.g., 310, Fig.6a];

a content store [Abstract; 38, Fig.3; e.g., a local message store] for storing at least one said dialog posting;

a dialog store [Abstract; 39, Fig.3; e.g., the client database] for altering a posting summary of said at least one dialog posting, a journal keeper [e.g., 37, Fig.3] coupled to said dialog store for examining said referential information to determine whether said dialog summary relates to an existing said posting summary in said dialog store, and assigning a unique dialog identifier to said posting summary if it is not related to an existing said posting summary in said dialog store [Fig.8]; and

a media coordinator using the posting identifier, the dialog identifier, and the referential information to present the spatial and temporal context of a selected dialog posting in relation to other said postings belonging to a given dialog [e.g., Fig.4a-4b; col.9, lines 46-55; col.4, line 66- col.5, line 19; note that since Kennedy's invention is

Art Unit: 2154

incorporated into the MICROSOFT OUTLOOK, the media coordinator is part of the enhanced OUTLOOK application program, which is able to present a posted message].

6. As to claim 2, Kennedy further teaches that said journal keeper updates said referential information of said related posting summaries to reference said posting summary, and stores said updated referential information in said dialog store [col.15, lines 15-27].

7. As to claim 3, Kennedy further teaches that said media coordinator enables a user to navigate between postings belonging to a given dialog, displays the content description information of selected posting summaries, and selectively retrieves one said dialog posting responsive to a user command and displays said posting detail information [col.1, lines 48-67; note that the selective retrieval of information and displaying of it are part of MICROSOFT OUTLOOK's functionalities].

8. As to claims 11-14, 22-24 and 32, since the features of these claims can also be found in claims 1-3, they are rejected for the same reasons set forth in the rejection of claims 1-3 above.

9. Claims 4-10, 15-21 and 25-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Grouse [U.S. PGPub 20020156848];
Chandra et al. [U.S. PGPub 20020138582];
Hillar et al. [U.S. PGPub 20020046245];
Satoh; et al. [U.S. Pat. No. 6675197]; and
Nishio; et al. [U.S. Pat. No. 6381651].

11. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 days from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

Conclusion

Examiner note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part

Art Unit: 2154

of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday (8:00-5:00) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)872-9306 for official communications; and

(571)273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

January 7, 2005

Wen-Tai Lin
1/7/05